

### **REMARKS**

Applicants respectfully traverse the rejections made in the outstanding Office Action.

#### **The Office Action**

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Polish (U.S. Patent No. 6,430,531).

#### **The Polish Reference**

Importantly, the Examiner seems to have misread or otherwise misinterpreted the Polish reference. Polish is directed to a general bilateral speech system. Polish proposes a speech processor that both speaks and listens using speech recognizers as well as speech synthesizers to allow a user to engage in a verbal dialog with a database. Polish explicitly distinguishes itself from so called unidirectional speech systems, e.g., one which has a speech input but otherwise non-speech output results.

Importantly, Polish never even mentions a telephone, telephone network, telephone call or any telephone system whatsoever.

#### **The Present Application Distinguishes over Polish**

Claim 1 calls for "receiving a telephone call from a viewer via a telephone system." Claim 11 calls for "a service control point connected to a telephone system" and comprising "query generating means for generating a search query in response to a telephone call received from a viewer via the telephone system." Contrary to the assertions made in the Office Action, Polish fails to expressly teach or fairly suggest the foregoing. Nowhere does Polish even mention a telephone, a telephone call, a telephone network, a service control point or any type of telephone system. Polish is completely silent as to this aspect. Should the Examiner feel otherwise, it is respectfully requested that the Examiner identify precisely where such aspect is to be found in Polish. Absent such a showing, Polish fails to teach all the elements and/or steps of the claims. Accordingly, claims 1 and 11, along with claims 2-10 and 12-20 that depend therefrom, distinguish patentably over Polish.

The Office Action acknowledges that "Polish does not explicitly disclose the search results are displayable." However, it goes on to take the position that such a feature would have been obvious to a person having ordinary skill in the art. Applicants

respectfully disagree. First, please note that Polish does not explicitly mention any type of television, monitor or display device. Second, recall that Polish teaches a bilateral speech system having both speech input and output, and expressly distinguishes itself from a unilateral speech system, e.g., having a speech input and displayed output.

Accordingly, Polish itself teaches directly away from claims 1 and 11 which explicitly recite “displayable” search results. MPEP §2145(X)(D)(1) is instructive in this area – “A prior art reference that ‘teaches away’ from the claimed invention is a significant factor to be considered in determining obviousness.” As is well settled, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP §2141.02. Furthermore, according to MPEP §2143.01, “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” In this case, the express purpose of the Polish invention is to have a bilateral speech system as opposed to a unilateral speech system, and clearly therefore, modifying the search results output by Polish to be displayable as opposed to spoken, renders the Polish invention unsatisfactory for its intended purpose.

**CONCLUSION**

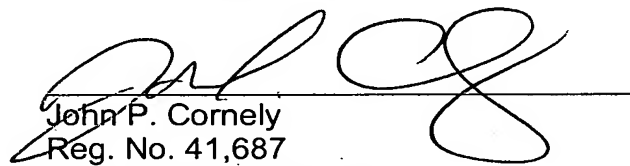
For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-20) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone John P. Cornely, at (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

January 3, 2005  
Date

  
John P. Cornely  
Reg. No. 41,687  
1100 Superior Avenue  
7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582

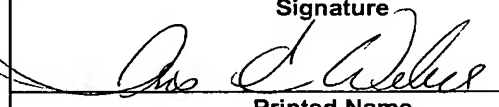
---

Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

- ☒ deposited with the United States Postal Service as First Class mail, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to the Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

<b>Express Mail Label No.:</b>
<b>Date</b> <b>January 3, 2005</b>

<b>Signature</b> 
<b>Printed Name</b> <b>Iris E. Weber</b>